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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/187,472	11/06/1998	ROGER A. ALLINGTON	17990-1-1	3109

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EXAMINER

BECKER, DREW E

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/187,472

Applicant(s)

ALLINGTON ET AL.

Examiner

Drew E. Becker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 82-111 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 82-111 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION


1. In view of the Appeal Brief filed on 5/9/06, PROSECUTION IS HEREBY REOPENED. A new rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


DIRECTOR, USPTO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 103 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The application does not appear to disclose generating a second parameter which is "at least one of... atmospheric pressure". Appellant points to page 7, line 34 through page 8, line 4, to provide support for the above limitation. However, the above citation merely describes the monitoring of the color/darkness of the beans during roasting, then controlling the roasting air temperature and flow rate (page 8, line 12).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 102-103 and 106-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi [Pat. No. 4,849,625] in view of Gell Jr [Pat. No. 4,494,314].

Camerini Porzi teaches a method of roasting coffee beans comprising a photoemitter element (Figure 1, #1), a photodetector for monitoring the color of the beans during roasting (Figure 1, #2), a colorimeter which produces an output signal equivalent to the

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desired color (Figure 1, #7; column 4, line 17), and a comparator which ends the roasting when the signals from the colorimeter and photodetector are equal (column 4, lines 22-26). Although not specifically recited, the desired color or darkness level of Camerini Porzi inherently possessed a desired aroma since both are properties of fully roasted coffee beans. Camerini Porzi does not recite generating a second parameter which reflects the development of the color during roasting and adjustment of the roasting when there is a deviation (claim 102), such as the roasting temperature (claim 103), and a multiplicity of different product types and roasting levels (claim 106-107). Gell Jr teaches a method for roasting coffee beans by selecting a bean type and degree of darkness from stored values (column 4, line 61 to column 5, line 19), monitoring the roasting temperature with a thermostat (Figure 2, #60), and adjusting the roasting temperature based upon the thermostat (column 7, lines 38-57). It would have been obvious to one of ordinary skill in the art to incorporate the control features of Gell Jr into the invention of Camerini Porzi since both are directed to methods of roasting coffee beans, since Camerini Porzi already included monitoring the bean color and ending the roasting based upon the bean color (column 4, lines 22-26), since thermostats were commonly used in food heating devices to control the heating temperature, and since the control features of Gell Jr permitted the automatic roasting of different bean types to many different degrees without the need for human intervention (column 4, line 61 to column 5, line 19).

6. Claims 104-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi, in view of Gell Jr, as applied above, and further in view of Grubbs et al

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[Pat. No. 4,110,485].

Camerini Porzi and Gell Jr teach the above mentioned concepts. Camerini Porzi and Gell Jr do not recite the use of a laser beam with a wavelength of 600-800 nm. Grubbs et al teach a method of evaluating coffee bean color comprising the use of a helium-neon gas laser with a wavelength of 632.8nm (column 7, lines 41-46). It would have been obvious to one of ordinary skill in the art to incorporate the laser of Grubbs et al into the invention of Camerini Porzi, in view of Gell Jr, since all are directed to methods of roasting coffee beans, since Camerini Porzi already included color evaluation of coffee beans by use of light beams (Figure 1, #1), and since Grubbs et al teach that the laser light source has only a single wavelength and therefor is simpler to calibrate (column 8, lines 30-36).

7. Claim 108-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi, in view of Gell Jr, as applied above, and further in view of Tidland [Pat. No. 5,958,494] and de Vries [Pat. No. 4,284,609].

Camerini Porzi and Gell Jr teach the above mentioned concepts. Camerini Porzi and Gell Jr do not recite removing pollutants from the roasting air, cooling the air to less than 115°F, exhausting the cool air into a room, reheating and recirculating a major portion of the air, and discharging a minor portion of the air. Tidland et al teach a method of roasting coffee beans including exhausting reconditioned air into the surrounding room of a retail store where the roaster is placed (column 2, lines 18-44; column 8, lines 5-17), reheating and recirculating a major portion of the air while

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discharging a minor portion of the air into the room (abstract; column 5, line 44). It would have been obvious to one of ordinary skill in the art to incorporate the exhaust features of Tidland et al into the invention of Camerini Porzi, in view of Gell Jr, since all are directed to methods of roasting coffee, since Camerini Porzi naturally required a means for exhausting roast air but simply did not describe it, and since the air reconditioning system of Tidland et al would have eliminated the need for outside venting of the exhaust gas (column 2, lines 18-44; column 8, lines 5-17). De Vries teaches a method of cleaning exhaust air from a coffee roaster (column 1, line 28) by removing pollutants from the exhaust air (column 6, line 11) and cooling the exhaust air to 110°F before discharge (column 8, line 5). It would have been obvious to one of ordinary skill in the art to incorporate the exhaust cooling of de Vries into the invention of Camerini Porzi, in view of Gell Jr and Tidland et al, since all are directed to methods of roasting coffee beans, since Tidland already included an exhaust system that vented into the surrounding room of a retail store (column 8, lines 5-17), and since the cooling of de Vries would have provided an efficient and convenient means of treating the exhaust air without polluting the surrounding environment with excessive heat.

8. Claims 82-85 and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi, in view of Tidland et al, and further in view of de Vries [Pat. No. 4,284,609].

Camerini Porzi and Tidland et al teach the above mentioned concepts. Camerini Porzi and Tidland et al do not recite cooling the gas to less than 115°F. De Vries teaches a method of cleaning exhaust air from a coffee roaster (column 1, line 28) by removing

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pollutants from the exhaust air (column 6, line 11) and cooling the exhaust air to 110°F before discharge (column 8, line 5). It would have been obvious to one of ordinary skill in the art to incorporate the exhaust cooling of de Vries into the invention of Camerini Porzi, in view of Tidland et al, since all are directed to methods of roasting coffee, since Tidland et al already included an exhaust system that vented into the surrounding room of a retail store (column 8, lines 5-17), and since the cooling of de Vries would have provided an efficient and convenient means of treating the exhaust air without polluting the surrounding environment with excessive heat.

9. Claims 94-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi in view of de Vries and Tidland et al.

Camerini Porzi teaches a method of roasting coffee beans comprising a photoemitter element (Figure 1, #1), a photodetector for monitoring the color of the beans during roasting (Figure 1, #2), a colorimeter which produces an output signal equivalent to desired color (Figure 1, #7; column 4, line 17), and a comparator which ends the roasting when the signals from the colorimeter and photodetector are equal (column 4, lines 22-26). Although not specifically recited, the desired color or darkness level of Camerini Porzi inherently possessed a desired aroma since both are properties of fully roasted coffee beans. Camerini Porzi does not recite removing pollutants in a filtration system, cooling a portion to less than 115°F, and exhausting it into the room without recirculating it. DeVries teaches a method cleaning exhaust air from a coffee roaster without recycling it (column 1, line 28) by removing pollutants from the exhaust air (column 6, line 11) and cooling the exhaust air to 110°F before discharge (column 8,

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line 5). It would have been obvious to one of ordinary skill in the art to incorporate the exhaust cooling and cleaning of de Vries into the invention of Camerini Porzi since both are directed to methods of roasting coffee, since Camerini Porzi would have required some means for exhaust but simply did not mention any specific structure, and since the cooling and cleaning of de Vries would have provided an efficient and convenient means of treating the exhaust air without polluting the surrounding environment with excessive heat and particulates. Tidland et al teach a method of roasting coffee beans including exhausting reconditioned air into the surrounding room of a retail store where the roaster is placed (column 2, lines 18-44; column 8, lines 5-17). It would have been obvious to one of ordinary skill in the art to incorporate the in-room exhaust of Tidland et al into the invention of Camerini Porzi, in view of de Vries, since all are directed to methods of roasting coffee, since de Vries already included means for exhausting cooled and cleaned gas (column 6, line 11; column 8, line 5), and since the air reconditioning system of Tidland would have eliminated the need for outside venting of the exhaust gas thus permitting the roaster to be placed in a retail store for easier customer access (column 2, lines 18-44., column 8, lines 5-17).

10. Claims 86-87 and 98-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi, in view of Tidland et al and de Vries, as applied above, and further in view of Grubbs et al [Pat. No. 4,110,485].

Camerini Porzi, de Vries, and Tidland et al teach the above mentioned concepts.

Camerini Porzi, de Vries, and Tidland et al do not recite the use of a laser beam with a wavelength of 600-800 nm. Grubbs et al teach a method of evaluating coffee bean color

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comprising the use of a helium-neon gas laser with a wavelength of 632.8nm (column 9, lines 41-46). It would have been obvious to one of ordinary skill in the art to incorporate the laser of Grubbs et al into the invention of Camerini Porzi, in view of Tidland and de Vries, since all are directed to methods of roasting, since Camerini Porzi already included color evaluation of coffee beans by use of light beams (Figure 1, #1), and since Grubbs et al teach that the laser light source has only a single wavelength and therefor is simpler to calibrate (column 8, lines 30-36).

11. Claims 88-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi, in view of de Vries and Tidland et al, as applied above, and further in view of Gell Jr [Pat. No. 4,494,314].

Camerini Porzi, de Vries, and Tidland et al teach the above mentioned concepts.

Camerini Porzi, de Vries, and Tidland et al do not recite a multiplicity of different product types and roasting levels. Gell Jr teaches a coffee roaster with settings for multiple types of beans and roasting levels (column 4, line 61 to column 5, line 19). It would have been obvious to one of ordinary skill in the art to incorporate the multiple setting and roasting levels of Gell Jr into the invention of Camerini Porzi, in view of Tidland and de Vries, since all are directed to methods of roasting coffee beans, since Gell Jr teaches that coffee beans come in different sizes and densities which can effect the roasting time (column 5, line 10), and since Camerini Porzi is primarily directed to controlling the roasting time of coffee beans by monitoring their color (column 1, lines 8-16).

12. Claims 90 and 111 are rejected under 35 U.S.C. 103(a) as being unpatentable

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over EP 0040823 in view of Tidland et al and de Vries.

EP 0040823 teach a method for controlling a coffee roaster comprising roasting a sample of coffee beans to provide a degree of doneness (Figure 1, P'), a color measuring devices which respond to the color of roasting coffee beans and sample (Figure 1, A & F), a comparison circuit (Figure 1, #14), and ending roasting when the two signals correspond (paragraphs 2-3). Although not specifically recited, the desired color or darkness level of EP 0040823 inherently possessed a desired aroma since both are properties of fully roasted coffee beans. EP 0040823 does not recite removing pollutants from the exhaust air, cooling the exhaust air to 115°F or less, and emitting the exhaust air into a room. Tidland teaches a method of roasting coffee beans including exhausting reconditioned air into the surrounding room of a retail store where the roaster is placed (column 2, lines 18-44; column 8, lines 5-17), reheating and recirculating a major portion of the air while discharging a minor portion of the air (abstract; column 5, line 44). De Vries teaches a method for cleaning exhaust air from a coffee roaster (column 1, line 28) by removing pollutants from the exhaust air (column 6, line 11) and cooling the exhaust air to 110°F before discharge (column 8, line 5). It would have been obvious to one of ordinary skill in the art to incorporate the exhaust cooling and cleaning of de Vries into the invention of EP 0040823 since both are directed to methods of roasting coffee, since EP 0040823 would have required some means for exhaust but simply did not mention any specific structure, and since the cooling and cleaning of de Vries would have provided an efficient and convenient means of treating the exhaust air without polluting the surrounding environment with

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excessive heat and particulates. It would have been obvious to one of ordinary skill in the art to incorporate the in-room exhaust of Tidland et al into the invention of EP 0040823, in view of de Vries, since all are directed to methods of roasting coffee, since de Vries already included means for exhausting cooled and cleaned gas (column 6, line 11; column 8, line 5), and since the air reconditioning system of Tidland et al would have eliminated the need for outside venting of the exhaust gas thus permitting the roaster to be placed in a retail store for easier customer access (column 2, lines 18-44., column 8, lines 5-17).

13. Claims 91 is rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi in view of de Vries, Tidland et al, and Grubbs et al as applied above, and further in view of Scher et al [Pat. No. 5,062,066].

Camerini Porzi, Tidland et al, Grubbs et al, and de Vries teach the above mentioned concepts. Camerini Porzi, Tidland et al, Grubbs et al, and de Vries do not recite controlling multiple roasting machines at different locations. Scher et al teach a control system for roasting comprising multiple roasters at inherently different locations (column 3, line 15) and monitoring the color of the product (column 5, line 16). It would have been obvious to one of ordinary skill in the art to control multiple roasters as taught by Scher et al with the invention of Camerini Porzi since both are directed to methods of roasting, since the multiple roasters of Scher et al would have created more diversified products and reduced the waiting time, and since Camerini Porzi teaches a remote processing unit which is located a distance away from the roaster (column 3, line 63).

14. Claim 92 is rejected under 35 U.S.C. 103(a) as being unpatentable over

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Camerini Porzi in view of Tidland et al, Grubbs et al, Scher et al, and de Vries as applied above, and further in view of Helbling [Pat. No. 5,158,793].

Camerini Porzi, Tidland et al, Grubbs et al, de Vries, and Scher et al teach the above mentioned concepts. Camerini Porzi, Tidland et al, Grubbs et al, de Vries, and Scher et al do not recite a step of keeping an inventory and generating a low inventory signal. Helbling teaches a method of making coffee including a weight sensor which detects when a station is empty and generates an "empty" signal (column 7, line 54). It would have been obvious to one of ordinary skill in the art to incorporate the weight control system of Helbling into the invention of Camerini Porzi since both are directed to methods of coffee production and since this would have been an effective means of maintaining a constant rate of roasting in Camerini Porzi by eliminating any long stoppages in the process due to an empty supply bin.

15. Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini Porzi in view of Tidland et al, Grubbs et al, Scher et al, and de Vries as applied above, and further in view of Gell Jr.

Camerini Porzi, Tidland et al, Grubbs et al, Scher et al, and de Vries teach the above mentioned concepts. Camerini Porzi, de Vries, Grubbs et al, Scher et al, and Tidland et al do not teach a multiplicity of different product types and roasting levels. Gell Jr teaches a coffee roaster with settings for multiple types of beans and roasting levels (column 4, line 61 to column 5, line 19). It would have been obvious to one of ordinary skill in the art to incorporate the multiple settings and roasting levels of Gell Jr into the invention of Camerini Porzi since both are directed to methods of roasting coffee beans,

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since Gell Jr teaches that coffee beans come in different sizes and densities which can effect the roasting time (column 5, line 10), and since Camerini Porzi is primarily directed to controlling the roasting time of coffee beans by monitoring their color (column 1, lines 8-16).

16. Claims 100-101 are rejected under 35 U.S.C. 103(a) as being unpaientable over Camerini Porzi, in view of de Vries, Tidland et al, and Grubbs et al, as applied above, and further in view of Gell Jr.

Camerini Porzi, Tidland et al, Grubbs et al, and de Vries teach the above mentioned concepts. Camerini Porzi, de Vries, Grubbs et al, and Tidland et al do not teach a multiplicity of different product types and roasting levels. Gell Jr teaches a coffee roaster with settings for multiple types of beans and roasting levels (column 4, line 61 to column 5, line 19). It would have been obvious to one of ordinary skill in the art to incorporate the multiple settings and roasting levels of Gell Jr into the invention of Camerini Porzi since both are directed to methods of roasting coffee beans, since Gell Jr teaches that coffee beans come in different sizes and densities which can effect the roasting time (column 5, line 10), and since Camerini Porzi is primarily directed to controlling the roasting time of coffee beans by monitoring their color (column 1, lines 8-16).

Response to Arguments

17. Applicant's arguments filed 5/9/06 have been fully considered but they are not persuasive.

Appellant argues that Camerini Porzi did not include monitoring a second parameter and adjusting the roast based upon the second parameter, such as the roasting temperature. However, the new rejection relies upon Gell Jr to teach a method for roasting coffee beans by selecting a bean type and degree of darkness from stored values (column 4, line 61 to column 5, line 19), monitoring the roasting temperature with a thermostat (Figure 2, #60), and adjusting the roasting temperature based upon the thermostat (column 7, lines 38-57). It would have been obvious to one of ordinary skill in the art to incorporate the thermostat of Gell Jr into the invention of Camerini Porzi since both are directed to methods of roasting coffee beans, since Camerini Porzi already included monitoring the bean color and ending the roasting based upon the bean color (column 4, lines 22-26), since thermostats were commonly used in food heating devices to control the heating temperature, and since the temperature control of Gell Jr permitted the automatic roasting of different bean types to many different degrees (column 4, line 61 to column 5, line 19).

Argument A3:

In response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., cooling the exhaust air) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Appellant argues that Tidland et al did not teach recirculating a major portion of the roast air, and exhausting a minor portion into the room during roasting. However, Tidland et al clearly teach recirculation and filtering of the major portion of the air (column 2, lines 17-44), and discharging a minor portion of the roast air into the surrounding room through exhaust filters during the roasting process (column 5, line 44).

Appellant argues that the minor venting of Tidland et al occurred before roasting began. However, Tidland et al clearly described this venting under the heading "Roasting Stages" (column 5, lines 18 & 44). Furthermore, Tidland et al described placing the beans in the chamber, then starting the airflow, then turning on the heaters, and then drawing hot air and smoke up through the filters while simultaneously venting excess hot air out through the exhaust filters which remove the pollutants (column 5, lines 19-52). There would be no smoke and pollutants unless the beans were actively being roasted. Clearly, the venting occurred at least during the initial stages of roasting.

Appellant argues that the vent filters of Tidland et al (#17-18) were inadequate for filtering out pollutants. However, Tidland et al clearly teach that these filters include a coarse filter for large particulate matter, as well as an electronic filter for micron-sized pollutants (column 4, line 25; column 2, line 33). These are the same types of filters (minus an odor filter) that were used by Tidland et al to clean the recirculated roast air (Figure 2, #72, 74, 76, 78). Clearly, they were effective at removing pollutants from the air.

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Appellant argues that if the roaster of Tidland et al were operated indoors, the operators would quickly suffocate. This is absolutely wrong. The primary purpose of Tidland et al was to filter and treat the roast air so that the machine could be operated within retail coffee shops (abstract).

Argument B1:

Appellant argues that none of the references teach discharging air into a room where people “may” be present. However, Tidland et al teach a method of roasting coffee beans including exhausting reconditioned air into the surrounding room of a retail coffee shop where the roaster is placed (column 2, lines 18-44; column 8, lines 5-17), reheating and recirculating a major portion of the air while discharging a minor portion of the air into the room (abstract; column 5, line 44).

Appellant argues that none of the references teach roasting to achieve a desired aroma. However, Camerini Porzi specifically teaches roasting the beans until a desired doneness has been achieved (column 4, lines 22-26), and this desired doneness inherently also possessed an aroma which would be desirable.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., geographically different locations or a location within a supermarket) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Camerini Porzi is directed to a method for roasting coffee beans by monitoring their color, deVries is directed to a method roasting coffee beans while cleaning and cooling the used roast air before discharging it (column 2, lines 11 & 30-60), and Tidland et al is directed to a method of roasting coffee beans while removing pollutants from the used roast air to permit operating the machine within a retail coffee shop (abstract).

Appellant argues that the minor venting of Tidland et al occurred before roasting began. However, Tidland et al clearly described this venting under the heading "Roasting Stages" (column 5, lines 18 & 44). Furthermore, Tidland et al described placing the beans in the chamber, then starting the airflow, then turning on the heaters, and then drawing hot air and smoke up through the filters while simultaneously venting

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excess hot air out through the exhaust filters which remove the pollutants (column 5, lines 19-52). There would be no smoke and pollutants unless the beans were actively being roasted.

Appellant argues that if the roaster of Tidland et al were operated indoors, the operators would quickly suffocate. This is absolutely wrong. The primary purpose of Tidland et al was to filter and treat the roast air so that the machine could be operated within retail coffee shops (abstract).

Argument C1:

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to appellant's argument that deVries did not recycle air and Tidland et al did, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, deVries teaches that it was beneficial to cool exhaust air from a roaster before discharging it (column 8, line 5), while Tidland et al

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teach that effective filtering removes pollutants from roast air which can then be exhausted into the surrounding room of a retail store (column 2, lines 18-44; column 8, lines 5-17). Both references are directed to treating exhaust air from coffee roasters, then exhausting the treated air.

Argument D1:

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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Argument E1:

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to appellant's argument that deVries did not recycle air and Tidland et al did, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, deVries teaches that it was beneficial to cool exhaust air from a roaster before discharging it (column 8, line 5), while Tidland et al teach that effective filtering removes pollutants from roast air which can then be exhausted into the surrounding room of a retail store (column 2, lines 18-44; column 8, lines 5-17). Both references are directed to treating exhaust air from coffee roasters, then exhausting the treated air.

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In response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., different rooms or buildings) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Appellant simply claims "geographically separate locations". Multiple roasters would inherently occupy "geographically separate locations" since they cannot physically share the same exact location.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E. Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Mon.-Fri. 8am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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7-21-06